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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,098

06/24/2004

Anne D. Frame

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7662

25223

7590

07/22/2008

WHITEFORD, TAYLOR & PRESTON, LLP

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BALTIMORE, MD 21202-1626

EXAMINER

LEITH, PATRICIA A

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

07/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,098

Applicant(s)

FRAME, ANNE D.

Examiner

Patricia Leith

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 26-35 and 39-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 26-31, 34, 35 and 42-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32, 33, 39-41, 47-49, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-15, 26-35 and 39-57 are pending in the application.

Claims 1-15, 26-31, 34-35 and 42-46 remain withdrawn from the merits as being directed toward a non-elected invention.

Claims 32-33 and 39-41, 47-49 and 56-57 were examined on their merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a previous Office Action.

The Declaration submitted on 6/24/08 by O. David Sparkman was fully considered. Said Declaration is persuasive to overcome the previous objection to the Specification for introduction of New Matter by the Applicant. The Declaration provides ample evidence to conclude that at the time the instant invention was made, that cobaltocene-octomethyl was the only compound found in the NIST library database and therefore, 1) 'cobaltocene-octomethyl' is considered the compound Applicant originally intended to disclose and 2) the recitation of 'cobaltocene-octomet' in the original disclosure as filed is considered an inadvertent spelling error.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 32-33 and 39-41, 48-49 and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenspan et al. (1996) in view of McMurtry (1992). It is noted that the examiner inadvertently omitted claims 47-49 from the previous rejection as improperly indicating that these claims were withdrawn from the merits as being directed toward a non-elected invention.

Applicant's arguments were fully considered, but not found persuasive.

Applicant cites *In re Adams*: "...Obviousness can not be predicted on what is unknown" and argues that "There is no reason why an antimicrobial agent would necessarily or likely have the insecticidal activity and vice-versa. Bacteria are

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prokaryotes. Insects are eukaryotes. Their membranes are different. The target tissue/molecule are typically different; antibacterial agents most commonly attack the ribosome, insecticidal agents often alter the permeability of membranes" (p. 4, Remarks). However, in the instant case, claim 32 for example, is a method for preparing a composition. The prior art does lack a teaching that the extract from *M. americana* displays antibacterial properties; however, it is reminded that the claims are *not composition claims but method claims*. The prior art makes clear that the method for producing the composition is obvious; that is, *the steps of the method are obvious*. The prior art, as disclosed by Greenspan produced a composition by a method which makes obvious the Instantly claimed method. Applicant has not verifiably indicated that the composition of Greenspan does not have the claimed characteristics, and hence, Applicant's arguments are not convincing.

While Applicant argues that the prior art only taught insecticidal activity and that "[i]f expectation of anti-bacterial activity were obvious, you would think one of these science teams would try to test also for antibacterial activity" (p. 4, Remarks), it is again stressed that the Instantly claimed invention is a method for preparing a composition and the recitation of 'wherein the composition has antimicrobial activity' is not given any patentable weight because the phrase 'wherein the composition has antimicrobial activity' is not further limiting the method steps of the claim. The method claims are compared with the prior art with respect to the steps in the method of the claimed invention. The prior art makes obvious the steps in the method. Although Applicant's

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claims state that the composition from *M.americana* is eluted from a column instead of produced from thin layer chromatography (TLC) as disclosed by Greenspan, it is deemed that the steps as recited in the Instant claims would produce a composition essentially the same as the composition disclosed by Greenspan. Therefore, there is strong presumption that the extract produced by Greenspan also has antibacterial activity because the compositions would be essentially the same. However, even if the extract produced by Greenspan et al. does not have antibacterial activity, the method is still obvious because, to reiterate, the statement in the claims which indicates that the extract has antimicrobial activity is not a limitation of the claim because it does not further limit the method steps. Thus, to be more specific, Applicant is reciting a method for preparing a composition which is an obvious variation of the prior art method for producing an extract. The statement in claim 32 which recites 'wherein the composition has antimicrobial activity' does not impart any patentable weight to the claim because the claim is a method claim. Thus, in order to obviate the outstanding rejection, Applicant should produce arguments which would necessarily indicate that the modification of the prior art method would not be obvious, however, Applicant has not established that the modification of the prior art steps would not be obvious but rather center their arguments around the incorrect contention that because the claim states that the composition has antimicrobial activity and because the prior art did not state that the composition has antimicrobial activity that the claim is obviated. Hence, Applicant's traversals are not sufficient in order to overcome the rejection because the claimed method is an obvious variation of the method of Greenspan.

Applicant is directed to MPEP § 2111.04:

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." Id. However, the court noted (quoting *Minton v. Nat 'l Ass 'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a ***"whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."*** Id.< (emphasis added).

Hence, it follows from *Minton v. Nat 'l Ass 'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) that none of the claims which specifically state what type of compounds are present in the extract of claim 32 hold any patentable weight because these claims do not further limit the actual method steps of the claim.

Claims 32-33 and 39-41, 47-49 and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenspan et al. (1996) in view of McCurry (1992) in view of Habtemariam et al. (US 6,225,342) **or** Kanojia (US 4,046,882 A).

Claim 47 states wherein the organic solvent of claim 32 is specifically methylene chloride (also known as dichloromethane).

The teachings of Greenspan et al. and McCurry were discussed in previous Office actions. It is reiterated that Greenspan incorporated hexane for extraction of *Mammea americana* leaves and seeds, however, did not specifically disclose use of methylene chloride.

Interchanging non-polar solvents was routine, conventional practice in the herbal extract art. Methylene chloride, also known as dichloromethane, was also a well known non-polar solvent (extractant) used to extract plant materials. Both Habtemariam et al. (US 6,225,342) as well as Kanojia et al. disclose the use of hexane or methylene chloride for use as a non-polar solvent in extracting plant material. While it is accepted, of course that hexane (as disclosed by Greenspan et al.) and dichloromethane are not *exactly* the same solvent one of ordinary skill in the art would have had a reasonable expectation of substituting the hexane of Greenspan et al. with methylene chloride because both of these solvents were known non-polar solvents used for plant extraction and known to be interchangeable. “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton” KSR 127S. Ct. at 1742. Applicant has not demonstrated within the instant disclosure as filed that methylene chloride fairs any better than any other non-polar solvent which is known, and conventionally used in

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the prior art. Therefore, the Applicant's use of methylene chloride over hexane, without showing any unexpected results therefrom, is considered an obvious variation of the method already disclosed in the art by Greenspan et al.

[If]... there are [a] finite number of identified, predictable solutions, [a] person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 U.S. 2007.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia Leith
Primary Examiner
Art Unit 1655

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